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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,757	11/20/2000	John J. Chen	S63.2-9494	8168

490 7590 01/13/2004

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

CHATTOPADHYAY, URMI

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 01/13/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 13

Application Number: 09/716,757
Filing Date: November 20, 2000
Appellant(s): CHEN ET AL.

MAILED
JAN 13 2004
GROUP 3700

Richard A. Arrett
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/10/03.

Art Unit: 3738

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because it states that the invention of claim 11 includes an outside surface being composed of a first material having a first predetermined hardness. Claim 11 does not require that the outside surface be composed of the first material.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 5, 9, 10 and 11 stand or fall together, claim 2 stands or falls alone, claim 3 stands or falls alone, claim 4 stands or falls alone and claim 12 stands or falls alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5,980,530

WILLARD et al.

11-1999

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5 and 9-12 are rejected under 35 U.S.C. 102(e). This rejection is set forth in prior Office Action, Paper No. 6.

(11) *Response to Argument*

Applicant argues that the entire sleeve of Willard is formed from a polyurethane tubing, so both the inside and outside surface of the sleeve is taught as being made from the same material, polyurethane. Also, Willard does not teach the reinforcing ring 34 is part of the sleeve, but only that the reinforcing ring is attached to the sleeve under the overlapping portion of the sleeve in contact with the stent. The examiner would like to point out that claims 1, 11 and 12 do not require that the sleeve *consist* of a tubing or any other limitation that restricts the sleeve from including different structural components. Because the reinforcing ring is attached to what Willard calls the sleeve, it is correct in interpreting the ring as being a part of the sleeve. Therefore, the ring makes up a portion of the inside surface of the sleeve.

Applicant argues that claims 1, 5, 9, 10, 11 and 12 each require that the inner surface of the sleeve be composed of a second material, i.e. the entire inside surface. Even if ring 34 is considered to be part of the sleeve (which applicant does not concede) the entire inside surface of the sleeve is not composed of the second material. In response, the examiner would like to make

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two points. First, the word "composed" is open, such as "comprising". This means that the inside surface of the sleeve must include a second material, but may also include other elements. Using the word "composed" does not limit the entire inside surface of the sleeve as *consisting* of a second material, which would require the entire inside surface to include only the second material. Therefore, Willard does indeed disclose an inside surface being "composed" of the second material. Second, in the species restriction set forth in paper no. 4, applicant had elected without traverse the species shown in Figure 1, with respect to the arrangement of materials. Figure 1 shows *a portion* of the inside surface of the sleeve being composed of the second material, as opposed to the other embodiment of Figure 2, which shows the entire inside surface being composed of the second material. Because the claims recite the inside surface as being "composed" of a second material, the examiner has interpreted that the part that is composed of the second material can be *a portion* of the inside surface, and therefore read on the elected embodiment. If applicant is attempts to amend the claims such that they are readable only on the non-elected species of Figure 2, they will be withdrawn from consideration.

Applicant argues that Willard fails to teach, suggest or motivate having a first material that is "necessarily" softer than the second material. The examiner disagrees. While the examiner agrees that polyimide and polyethylene are commercially available in shore D hardness ranges that overlap with polyurethane, the applicant has not addressed the combination of materials relied on by the examiner to reject the claims. Willard clearly discloses that the ring, which makes up the inside surface second material, can be made from a metal, such as platinum, gold, stainless steel or nitinol. Platinum, for example, is inherently harder than any of the elastomer materials (polyurethane, silicone, latex, polyether amide) disclosed for the outside

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surface first material. In this disclosed combination of metal and elastomer, the first material is indeed necessarily softer than the second material.

With respect to claim 2, applicant argues that even if the ring is considered to form part of the inner surface of the sleeve (which applicant does not concede), the remainder of the inner surface of the sleeve is comprised of the same material as the outside surface of the sleeve - and is therefore not smoother. Claim 2 only requires that the second material be smoother than the first material; it does not require that the entire inside surface consist of the smoother second material. See response to claim 1, above. It appears from the specification on page 5, lines 15-17 that because the stent retaining sleeve with a greater hardness provides the sleeve with lower frictional engagement to the stent, the sleeve would be "smoother". Following this logic, because the second material (metal) of Willard is inherently harder than the first material (elastomer), the second material would be smoother.

With respect to claims 3 and 4, applicant argues that there is no disclosure at all in Willard related to a sleeve formed of two materials, the first material having a hardness of less than approximately 55D (claim 3) or having a hardness of approximately 35D (claim 4) and the second material having a hardness of at least 55D (claim 3) or a hardness of approximately 55D (claim 4). The examiner agrees that Willard does not specifically state the durometer values of the first and second materials. However, since applicant's specification on pages 7-8, lines 5-5 give polyurethane and polyamide as examples of appropriate choices for first and second materials, respectively, it is inherent that these materials would meet the required durometer values of claims 3 and 4.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

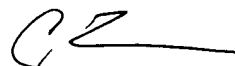


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December 18, 2003

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